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In re Application of MAY
U.S. Application No.: 10/529,326
PCT Application No.: PCT/EP2003/010634
Int. Filing Date: 24 September 2003
Priority Date Claimed: 25 September 2002
Attorney Docket No.: 119508-00282
For: TORQUE SIGNAL TRANSMISSION

DECISION

This is in response to applicant's "Fourth Renewed Petition Under 37 C.F.R. § 1.47(b)" filed 05 February 2009.

BACKGROUND

On 24 September 2003, applicant filed international application PCT/EP2003/010634, which claimed priority of an earlier United Kingdom application filed 25 September 2003. A copy of the international application was communicated to the USPTO from the International Bureau on 08 April 2004. The thirty-month period for paying the basic national fee in the United States expired on 25 March 2005.

On 25 March 2005, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 31 August 2005, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 28 October 2005, applicant filed a petition under 37 CFR 1.47(b).

On 23 June 2006, this Office mailed a decision dismissing the 28 October 2005 petition.

On 26 December 2006, applicant filed a renewed petition under 37 CFR 1.47(b).

On 02 April 2007, this Office mailed a decision dismissing the 26 December 2006 petition.

On 04 June 2007, applicant filed a second renewed petition under 37 CFR 1.47(b).

On 20 August 2007, this Office mailed a decision dismissing the 04 June 2007 petition.

On 20 February 2008, applicant filed a third renewed petition under 37 CFR 1.47(b).

On 09 July 2008, this Office mailed a decision dismissing the 20 February 2008 petition.

On 05 February 2009, applicant filed the present fourth renewed petition under 37 CFR 1.47(b).

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(i), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. See 37 CFR 1.47(b).

Petitioner has previously satisfied items (1), (2), (3), (4), and (6) above.

With regard to item (5) above, the 37 CFR 1.47(b) applicant must prove that, as of the date the application was deposited in the Patent and Trademark Office, (A) the invention has been assigned to the applicant, or (B) the inventor has agreed in writing to assign the invention to the applicant, or (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify filing of the application. MPEP 409.03(f).

The petition states that Abas, Inc. ("Abas") has ownership of the application. Therefore, applicant must demonstrate a chain of title of the invention from Lutz May to Abas. The present renewed petition adequately demonstrates that Fast Technology AG ("Fast") obtained rights to the invention from inventor May. In particular, the new affidavit of Klaus Gennen discusses the German court decision which held that Fast did not obtain rights to the invention from the inventor May. Mr. Gennen states that such court decision has been appealed and provides reasons as to why Mr. Gennen believes the court decision will be overturned on appeal. Petitioner has previously established that Fast sold the present invention to Magna-lastic Devices, Inc. ("Magna-lastic"). The original memorandum of Klaus Gennen states that Magna-lastic assigned the rights to the present invention to Abas (see Gennen memorandum, ¶25). Petitioner has supplied a copy of an assignment agreement which indicates that Fast assigned the present invention to Abas in June 2004. However, as stated in the decision mailed 09 July 2008,

petitioner has not explained how the assignment from Fast to Abas was executed after rights to the invention were sold to Magna-lastic.

CONCLUSION

For the reasons above, the fourth renewed petition under 37 CFR 1.47(b) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Extensions of time are available under 37 CFR 1.136. Failure to timely file a proper response will result in abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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